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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78897251
Applicant	Tele-Town Hall, LLC
Applied for Mark	TELE TOWN HALL
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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE: Tele-Town Hall, L.L.C.	
SERIAL NO: 78/897,251	Appeal No. _____
MARK: TELE TOWN HALL	
FILED: May 31, 2006	
LAW OFFICE: 111	

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
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APPEAL BRIEF

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Dear Sir:

Please enter the following Appeal Brief into the record. It urges reversal of the Examining Attorney's final refusal to register the above-stated mark under Section 2(d) of the Trademark Act.

I. INTRODUCTION

The Examining Attorney has rejected Appellant's mark on the basis that the proposed mark when used with the identified services is likely to be confused with U.S. Reg. No. 2,800,397 ("the '397 mark") for the THT TOWNHALL TELECONFERENCING mark and logo under Trademark Act Section 2(d).

For the reasons set forth below, Appellant's mark TELE TOWN HALL is not likely to be confused with the '397 mark under Trademark Act Section 2(d).

II. LEGAL ARGUMENT

A. The Legal Standard Under Trademark Act Section 2(d)

Section 2(d) of the Trademark Act precludes registration of a mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods [services] of the applicant, to cause confusion . . . " Trademark Act Section 2(d), 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (CCPA 1977) sets forth the factors that are considered in determining likelihood of confusion. *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2004). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks, and the similarities or dissimilarities between the goods. *Federated Foods, Inc. v. Ft. Howard Paper Co.*, 544 F.2d, 1098, 192 U.S.P.Q. 24 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531 (Fed.

Cir. 1997). These two key considerations and other *du Pont* factors are pertinent in finding no likelihood of confusion between Appellant's mark and the '397 mark. As explained below, here there is no likelihood of confusion because: (1) the commercial impression of the marks are different; (2) the marks are verbalized differently; (3) the marks are in fact different groupings of words; and (4) the services offered are different.

1. Comparison of the Marks

To determine whether two marks are confusingly similar, the appearance, sound, connotation, and commercial impression of each mark must be considered. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005). Because likelihood of confusion depends on the overall impression of the marks, similarities and dissimilarities of the two marks must be scrutinized. *In re Electrolyte Labs*, 929 F.2d 645, 647, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990). Similarity of the marks in one respect – sight, sound or commercial impression – will not automatically result in a finding of likelihood of confusion even if the goods are closely related. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, n.4 (TTAB 1987). As a separate element or as the sum of the three, one must also compare the commercial impressions created by the marks. *Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1450, 8 U.S.P.Q.2d 1237, 1242 (9th Cir. 1988); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 U.S.P.Q. 390, 394 (Fed. Cir. 1983).

The Examining Attorney asserts that the common usage of "Townhall" and "Tele" in the respective marks renders the marks nearly identical in appearance, sound and meaning, and the addition of the design element of the '397 mark does not obviate the similarity of the marks. (Office Action, pgs. 2-3). The Examining Attorney cites *In re*

Shell Oil Company, 26 U.S.P.Q.2d, 1687 (Fed. Cir. 1993) as a basis for this rejection. However, this case is not on point. Unlike the marks in the instant matter, TELE TOWN HALL and THT TOWNHALL TELECONFERENCING, the marks in *In re Shell Oil Company* contained identical words in both marks – RIGHT-A-WAY – and included an identical design element - an arrow - in both marks.

In the instant matter, the words of the respective marks are not identical and do not include an identical design element. Appellant's mark, TELE TOWN HALL, includes only three words – "Tele," "Town," and "Hall" and does not include a design element.

TELE TOWN HALL

The '397 word mark consists of three letters – "T-H-T" - followed by two words – "Townhall," and "Teleconferencing." Additionally, the '397 mark includes a design element which appears in the middle of the mark consisting of fanciful-type lettering of the T-H-T, with the H much taller, and with a clock tower in the uprights of the H.

A look at the two marks visually reveals the distinct differences between the marks. However, it does not take a side-by-side comparison to note the differences. Appellant's mark simply consists of three words - "Tele" – "Town" – "Hall." In contrast, the '397 mark consists of letters (T-H-T), two multi-syllable words (TOWNHALL and

TELECONFERENCING), all in different font style, and a design element in the center of the mark which includes fanciful-type lettering with a pictorial of a clock tower.

When a composite mark includes words and design, the design element is likely to be dominant if it is more conspicuous, as is the case here. *Assoc. of Co-operative Members, Inc. v. Farmland Industries, Inc.*, 216 U.S.P.Q. 361, 367 (5th Cir. 1982) (citation omitted). Applicant's mark is not a composite mark but consists of only words – TELE TOWN HALL. The '397 mark consists of both words and a design in which the design appears in the middle of the mark consisting of fanciful-type lettering of the T-H-T, with the H much taller and with a clock tower in the uprights of the H. TELECONFERENCING is arched over the T-H-T and TOWNHALL appears under the T-H-T. It is clear the fanciful T-H-T with the clock tower is the dominant portion of the mark. It does not take even a close look at the two marks to visually see the distinct differences between the marks. As the old saying goes, a picture is worth a thousand words and, here, the picture is distinctly different. The distinct differences in appearance between the two marks weigh against a likelihood of confusion.

Further, the sound of the marks is distinctly different. Appellant's mark consists of three words made up of four syllables and vocalized as TELE - TOWN - HALL. The '397 mark is made up of three letters followed by two words consisting of eight syllables and vocalized as T – H – T – TOWNHALL – TELECONFERENCING. The respective marks do not begin or end with the same word. The rhythm of the respective marks is different in that Appellant's mark consists of three short words, only the first having two syllables. The '397 mark has a progressing rhythm when the mark is vocalized as each portion of the mark contains more syllables. First, the letters: T-H-T; then a two-syllable word: TOWNHALL; and finally a six-syllable word: TELECONFERENCING. It is

clear in vocalizing each of the marks, the sound is distinctly different which weighs against a likelihood of confusion.

The distinct differences in both appearance and sound between the two marks weigh in favor of Appellant's word mark TELE TOWN HALL and against a likelihood of confusion.

2. Comparison of Services

Any likelihood of confusion between Appellant's mark TELE TOWN HALL and the '397 mark THT TOWNHALL TELECONFERENCING is further diminished by the differences in the nature of the services offered under the respective marks. "The issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category." *Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (TTAB 1992). In fact, the courts have avoided identifying goods so broadly. *See e.g., Zazu Designs v. L'Oreal S.A.*, 979 F.2d 499, 24 U.S.P.Q.2d 1828 (7th Cir. 1992) (finding no confusion for ZAZU for hair salon and ZAZU for hair care products); *In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987) (finding no likelihood of confusion for CROSSOVER for brassieres and CROSSOVER for ladies' sportswear); *In re Best Products Co., Inc.*, 231 U.S.P.Q. 988 (TTAB 1986) (finding no likelihood of confusion between JEWELRY'S BEST for watch bracelets and BEST JEWELRY for retail jewelry stores); *Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445, 213 U.S.P.Q. 1091 (S.D.N.Y. 1982) (finding no confusion between BENEFICIAL for consumer loans and BENEFICIAL CAPITAL for business loans); *The Conde Nast Publg., Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422, 425 (CCPA 1975) (finding no likelihood of confusion as to the source or sponsorship between the mark

COUNTRY VOGUE for ladies and misses dresses and the mark VOGUE for a fashion magazine even though both marks related to women's fashions); *In re P. Ferrero and C.S.p.A.*, 479 F.2d 1395, 178 U.S.P.Q. 167, 168 (CCPA 1973) (finding no likelihood of confusion between the mark TIC TAC for candy and the mark TIC TAC TOE for ice cream even though both products are inexpensive snack foods offered for sale in supermarket and convenience stores). Likewise, the overlap of the similar elements in the respective marks in the instant matter does not render Appellant's mark, TELE TOWN HALL, and the '397 mark, THT TOWNHALL TELECONFERENCING, confusingly similar.

In this case, the services offered under Applicant's mark and those offered under the '397 mark are distinctly different. However, the Examining Attorney places the respective services into the broad category of "teleconferencing" services. (Office Action, pg. 2-3). This broad categorization runs contrary to the case law cited above. The Examining Attorney bases the refusal to register, in part, on *In re General Motors Corp.*, 196 U.S.P.Q. 574 (TTAB 1977); however, this case is not on point. In *General Motors*, the respective marks were identical, STAR FIRE. The Examining Attorney presents no specific facts or evidence that the *General Motors* case is on point with the facts in the instant matter. The Examining Attorney bears the burden of presenting such a factual basis and has not done so in this regard.

It is well settled that the question of likelihood of confusion must be determined based on an analysis of the relatedness of the goods or services between an applicant and a registrant on what is recited in an applicant's application vis-à-vis the goods or services recited in the registration, rather than "how" the goods or services can be described. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2d 1783 (Fed.

Cir. 1992); *The Chicago Corp. v. North Am. Chicago Corp.*, 20 U.S.P.Q.2d 1715 (TTAB 1991). The services marketed under Appellant's TELE TOWN HALL mark are distinct and specifically limited to "internet telephony services; telephone conferencing services." The services offered under the '397 mark are directed to "audio, video, web, and streaming teleconferencing services." Although it may be true that the respective services offered under the Applicant's mark and under the '397 mark may both be broadly described as "teleconferencing" services as noted by the Examining Attorney, to demonstrate that goods or services are related, it is not sufficient that a particular term may be found which may generally describe them. *See Gen. Electric Co. v. Graham Magnetics Corp.*, 197 U.S.P.Q. 690 (TTAB 1977); *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 U.S.P.Q. 517 (TTAB 1975); *In re Cotter*, 179 U.S.P.Q. 828 (TTAB 1973). In the instant matter, the services offered under the '397 mark are not legally identical to the services under Appellant's mark. Thus, with the legally distinguishable services, along with the distinct differences in the sound and appearance between the marks, a likelihood of confusion does not exist.

3. "Possible" Confusion is Insufficient

Likelihood of confusion has been said to be synonymous with "probable" confusion, that is, it is not sufficient if confusion is merely "possible." *See e.g. Estee Lauder, Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510, 42 U.S.P.Q.2d 1228, 1232-33 (2d Cir. 1997) ("Likelihood of confusion means a probability of confusion; 'it is not sufficient if confusion is merely possible,'"); *Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 193, 46 U.S.P.Q.2d 1737, 1740 (5th Cir. 1998) ("Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion."). A mere theoretical possibility of confusion, deception or mistake is

insufficient to show "probability." *See Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.3d 713, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (citation omitted). The Examining Attorney offered nothing to suggest that a likelihood of confusion would be more than a possibility. Once again, this weighs in favor of Appellant in registration of its mark.

B. Anti-Dissection Rule

Under the anti-dissection rule, a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts. 2 McCarthy on Trademarks and Unfair Compeition, § 11:27 (2006). As the United States Supreme Court stated: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety." *Estate of Beckwith, Inc. v. Comm. of Patents*, 252 U.S. 538, 545-46 (1920). While the basic rule is that marks must not be dissected, but compared in their entireties, "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re Natl. Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985). "The dominant element of a trademark is the element most readily associated with the products or services it identifies." *Assoc. of Co-operative Members*, 216 U.S.P.Q. at 361 (citation omitted). When a composite mark includes both words and a design, the design element is likely to be dominant if it is more conspicuous. Id.

In the Examining Attorney's refusal the word elements "Townhall" and "Tele" of Appellant's mark are noted as a basis for the likelihood of confusion with the '397 mark. (Office Action, pg. 3). The design element of the '397 mark is completely ignored.

The design element of the '397 mark predominates in size and appearance in the mark. As previously described, the fanciful-type THT lettering appears dominantly in the middle of the mark in that it sits in the center of the mark; TOWNHALL appears across the bottom of the mark in bold, block lettering; TELECONFERENCING appears in an arched-fashion over the top of the mark in yet another style of font; and a pictorial of a clock tower appears in the uprights of the "H." It is only by mark dissection of the word portion of Appellant's mark, and ignoring the design element of the '397 mark, that the Examining Attorney can make the argument that the marks are similar as to create the same commercial impression and cause a likelihood of confusion since nothing remotely similar to the design element of the '397 mark is contained as part of Appellant's mark. Additionally, the Examining Attorney dissects "Tele" and "Townhall" from Appellant's mark. "Tele" appears as the first word of Appellant's mark. "Town" and "Hall" appear as two words – the second and third words – in Appellant's mark. In the '397 mark, "Tele" does not appear as a single word, but as part of the word "Teleconferencing" which is the last word of the '397 mark. "Teleconferencing" is preceded by the first portion of the mark, THT, and the second word of the mark, "Townhall." The Examining Attorney has

impermissibly dissected Appellant's word mark as well as ignored the design element of the '397 mark as a basis for the refusal. *See In re Natl. Data Corp.*, 224 U.S.P.Q. at 750-51. Viewed in this light, Appellant's mark creates a fundamentally different commercial impression. Much like the word "lightning" and the words "lightning bug," both share the word "lightning" but the commercial impression is distinctly different. Put another way, when the composite mark is considered as a whole, and the way the public actually sees it, the two marks are not sufficiently similar to cause a likelihood of confusion. As such, Appellant's mark will not likely be confused with the '397 mark.

III. ORAL ARGUMENT REQUEST

Appellant hereby requests oral argument in this case. It is not believed a fee is due with this request. However, if a fee is due, please consider this a request to debit Deposit Account No. 26-0084 accordingly.

IV. CONCLUSION

For the above-stated reasons, Appellant's mark TELE TOWN HALL is not confusingly similar to the '397 mark. Appellant therefore respectfully requests that the Examining Attorney's final refusal to register dated December 3, 2006, be reversed and Appellant's mark be forwarded for publication.

Respectfully submitted,

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